

**Notice of Allowability**

Application No.

10/804,884

Examiner

Susannah Chung

Applicant(s)

SOLANKY ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/13/2006.
2. ☒ The allowed claim(s) is/are 1-7.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application                      |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>8/23/2004</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                    | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

### DETAILED ACTION

Claims 1-7 are pending in the instant application.

#### *Priority*

This application is a CON of PCT/IB03/06204, filed 12/25/2003.

#### *Information Disclosure Statement*

The information disclosure statement (IDS), filed on 8/23/2004 has been considered.

Please refer to Applicant's copy of the 1449 submitted herewith.

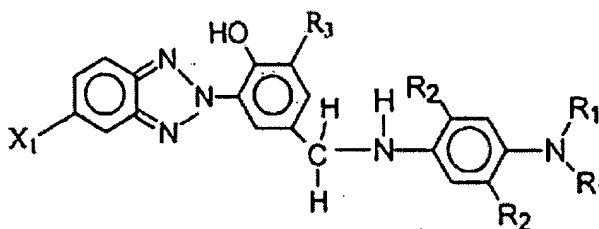
#### *Response to Election/Restrictions*

Applicant's election without traverse of Group I in the reply filed on 11/13/2006 is acknowledged. Specially, the election of species of the compound of Formula (I), wherein R1-R3 are hydrogen and X1 is bromine. Applicant's representative, Van Nguyen was contacted on 12/13/2006 to confirm the election and replace R1-R2 with methyl rather than hydrogen to fit the scope of the claims.

#### *Scope of the Elected Invention*

Claims 1-7 are pending in this application.

The scope of the elected subject matter that will be examined and searched is as follows:



Compounds of formula (I),  
in claim 1, page 19, wherein:

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R<sub>1</sub> and R<sub>2</sub> are selected from the group consisting of C<sub>1</sub> to C<sub>8</sub> linear and branched alkyls,  
R<sub>3</sub> is selected from the group consisting of hydrogen and tert-butyl, and  
X<sub>1</sub> is selected from the group consisting of hydrogen, halogen, tert-butyl and C<sub>1</sub> to C<sub>12</sub> alkoxy;  
and wherein the compound has antioxidant and antiozonant properties.

*Scope of Withdrawn Subject Matter*

Claims 2-7 are withdrawn from further consideration by the examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

*Rejoinder*

Claim 1 is directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(b), claims 2-7, directed to the process of making or using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, mailed 5/8/2006 is hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because a claimed invention previously withdrawn from consideration under 37 CFR 1.142 has been rejoined, **the restriction requirement set forth in the Office action mailed on 5/8/2006 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction

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requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### ***Reasons for Allowance***

The present invention is directed to Benzotriazole UV absorbers of Formula (I) and the process of making it. The closest prior art of record is Applicant's patent, U.S. Pat. No. 6,492,518 (Desai et al.), which teach similar benzotriazole compounds, except that in the instant application the terminal end of the compound is a phenyl ring substituted with two alkyl groups and a nitrogen containing group, while in the prior art the terminal end is a piperidine ring substituted with five methyl groups.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

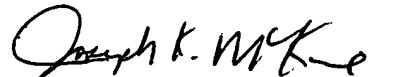
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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